

REMARKS

In an Office Action mailed on August 25, 2004, the Examiner maintained the § 103 rejections of claims 1-27 under 35 U.S.C. § 103(a) as being unpatentable over Choi in view of Firooz. Claim 1 has been amended to correct a potential antecedent basis problem and clarify that the writing in line 7 of claim 1 refers to writing the modified first basic input/output system *image* (*emphasis added*). Because this amendment corrects an obvious typographical error, entry of the amendment is requested. The § 103 rejections are addressed below.

Rejections of Claims 1-9:

A *prima facie* case of obviousness has not been established for independent claim 1 for at least the reason that the Examiner fails to show where the prior art allegedly teaches or suggests modifying a basic input/output system image that replaces an existing basic input/output system image.

More specifically, the Examiner relies on Firooz to allegedly teach this modification (although, as acknowledged by the Examiner, Firooz does not disclose a basic input/output system image). More particularly, although Firooz teaches replacing a portion of existing firmware 108 with "new code" (Firooz, 4:59-63) Firooz does not teach or suggest modifying this "new code," and thus, does not teach or suggest, the modifying of claim 1. Instead, Firooz clearly teaches modifying the existing firmware 108, not modifying replacement code of the firmware 108. Choi fails to teach or suggest the missing claim limitations. Therefore, for at least this reason, a *prima facie* case of obviousness has not been established for independent claim 1.

A *prima facie* case of obviousness has not been established for independent claim 1 for at least the additional, independent reason that the Examiner fails to show where the prior art contains the alleged suggestion or motivation to modify Choi in view of Firooz. Therefore, for at least any one of the above-mentioned reasons, a *prima facie* case of obviousness has not been established for independent claim 1.

Claims 2-9 are patentable for at least the reason that these claims depend from an allowable claim. Therefore, for at least the reasons that are set forth above, withdrawal of the § 103(a) rejections of claims 1-9 is requested.

Rejection of Claims 10-18:

The computer system of independent claim 10 includes a processor to modify a replacement basic input/output system image.

Contrary to the limitations of independent claim 10, the hypothetical combination of Choi and Firooz fails to teach or suggest all claim limitations. In particular, this hypothetical combination fails to teach or suggest modifying a replacement basic input/output system image or any firmware image. More specifically, there is no teaching or suggestion in Firooz regarding modifying the "new code" and writing the modified new code to the firmware 108. Likewise, Choi does not teach or suggest the missing claim limitations. Therefore, for at least this reason, a *prima facie* case of obviousness has not been established for independent claim 10.

A *prima facie* case of obviousness has not been established for independent claim 10 for at least the additional, independent reason that the Examiner fails to show where the prior art contains the alleged suggestion or motivation to modify Choi's technique for updating a ROM BIOS with Firooz's method of partial updates. Without a showing of such a suggestion or motivation, a *prima facie* case of obviousness has not been established for independent claim 10.

Claims 11-18 are patentable for at least the reason that these claims depend from an allowable claim. Therefore, for at least the reasons that are set forth above, withdrawal of the § 103(a) rejections of claims 10-18 is requested.

Rejections of Claims 19-27:

The article of independent claim 19 includes a computer readable storage medium that stores instructions to cause a processor to modify a replacement basic input/output system image.

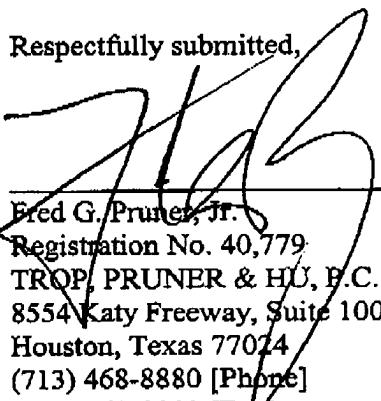
See discussions of independent claims 1 and 10 above. In particular, the hypothetical combination of Choi and Firooz fails to teach or suggest instructions to cause a processor to modify a replacement basic input/output system image, as Firooz's discussion of "new code" does not involve such a modification. Furthermore, Choi fails to teach or suggest the missing claim limitations. A *prima facie* case of obviousness has not been established for independent claim 19 for at least the additional, independent reason that the Examiner fails to show where the prior art contains the alleged suggestion or motivation for the modification of Choi in view of Firooz.

Claims 20-27 are patentable for at least the reason that these claims depend from an allowable claim. Therefore, for at least the reasons that are set forth above, withdrawal of the § 103(a) rejections of claims 19-27 is requested.

CONCLUSION

In view of the foregoing, withdrawal of the § 103(a) rejections of claims 1-27 and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0627US).

Respectfully submitted,


Fred G. Pruner, Jr.
Registration No. 40,779
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, Texas 77024
(713) 468-8880 [Phone]
(713) 468-8883 [Fax]

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